



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,797	12/29/2000	Laure Dumoutier	LUD-5543.3 CONT.	5783

24972 7590 03/26/2002

FULBRIGHT & JAWORSKI, LLP  
666 FIFTH AVE  
NEW YORK, NY 10103-3198

EXAMINER

DECLoux, AMY M

ART UNIT	PAPER NUMBER
----------	--------------

1644

DATE MAILED: 03/26/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/751,797

Applicant(s)

Dumoutier et al.

Examiner

DeCloux, Amy

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Dec 19, 2000

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 3, 4, 7, 8, 10, 11, 14-16, 18, and 19 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☒ Claims 3, 4, 7, 8, 10, 11, 14-16, 18, and 19 are subject to restriction and/or election requirements.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

### Detailed Action

1. A restriction is required under 35 USC 121 between one of the following groups:

I. Claims 1, 3-4, 7-8, 10-11, 14-16 and 18-19, drawn to an isolated nucleic acid molecule which encodes a T cell derived inducible factor, the complementary sequence of which hybridizes, under stringent conditions to at least one of SEQ ID NO:7 or SEQ ID NO:8, a vector thereof, and a recombinant cell comprising said isolated nucleic acid, classified in class 536, subclass 23.5 and class 435, subclasses 320.1 and 325,

II. Claims 1, 3-4, 7-8, 10-11, 14-16 and 18-19, drawn to an isolated nucleic acid molecule which encodes a T cell derived inducible factor, the complementary sequence of which hybridizes, under stringent conditions to at least one of SEQ ID NO:9 or SEQ ID NO:29, a vector thereof, and a recombinant cell comprising said isolated nucleic acid, classified in class 536, subclass 23.5 and class 435, subclasses 320.1 and 325, or

III. Claims 1, 3-4, 7-8, 10-11, 14-16 and 18-19, drawn to an isolated nucleic acid molecule which encodes a T cell derived inducible factor, the complementary sequence of which hybridizes, under stringent conditions to at least one of SEQ ID NO:24 or SEQ ID NO:25, a vector thereof, and a recombinant cell comprising said isolated nucleic acid, classified in class 536, subclass 23.5 and class 435, subclasses 320.1 and 325.

Note: Each claim will be examined only to the extent of the elected invention.

The inventions are distinct, each from the other because:

2. Groups I-III, are unique products. Group I encompasses a nucleic acid molecule that encodes a murine cDNA (SEQ ID NO:7) and its associated genomic DNA (SEQ ID NO:8). Each of the nucleic acid molecules encompassed by Group I has a distinct sequence from the nucleic acid molecules encompassed by Group II which includes another murine cDNA (SEQ ID NO:9) and its associated genomic DNA (SEQ ID NO:29). Group III encompasses a nucleic acid molecule that encodes a human cDNA (SEQ ID NO:24) and its associated genomic DNA (SEQ ID NO:25). Each of these nucleic acid molecules of Group III has a distinct sequence from the nucleic acid molecules encompassed by either Group I or Group II. Since Groups I, II and III encompass nucleic acid molecules with unique biochemical and structural characteristics, Groups I-III are patentably distinct, each from the other.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be

traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy DeCloux whose telephone number is (703) 306-5821. The examiner can normally be reached Monday through Friday from 9:00 am to 6:00 pm. a message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. a dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. a Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot Program. If you have any questions or suggestions, please contact Paula Hutzell, Supervisory Patent Examiner at paula.hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers (**other than elections**) should be faxed to Technology Center 1600 via the PTO Fax Center located In Crystal Mall 1. The faxing of such papers must conform with the notice published In the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Amy DeCloux, Ph.D.  
Patent Examiner  
Group 1640, Technology Center 1600  
March 25, 2002

*Amy DeCloux*

3-25-02